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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RANDY L. HACKBARTH,
JAMES DAVID HERBSLEB,
and GRAHAM JOHN WILLS

Appeal 2009-000934
Application 09/886,876
Technology Center 2100

Before JAMES D. THOMAS, HOWARD B. BLANKENSHIP, and
JAY P. LUCAS, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

INTRODUCTION

Appellants' Request for Rehearing (filed Oct. 18, 2010) contends that we erred in our Decision on Appeal entered August 16, 2010 ("Decision"), in which we affirmed the Examiner's decision to reject claims 1-27.

DISCUSSION

Appellants submit that they request a rehearing in accordance with 37 C.F.R. § 41.52(a)(2), based upon the recent U.S. Court of Appeals for the Federal Circuit decision in *King Pharmaceuticals, Inc. v. Eon Labs, Inc.*, 616 F.3d 1267 (Fed. Cir. Aug. 2, 2010). According to Appellants, *King Pharmaceuticals* "holds" that there are two different standards for evaluating whether to assign patentable weight to printed matter (non-functional descriptive material) limitations in a product claim and in a method claim. Req. Rhg 3. Appellants submit that we applied the incorrect standard because representative claim 1 is directed to a method rather than a product. *Id.*

The Examiner rejected claim 1 under 35 U.S.C. § 103(a) over the combination of Tang and Seybold. The Examiner found (*e.g.*, Ans. 3-4) that Tang taught essentially all of the subject matter of claim 1, including "dynamically displaying a visual representation having a plurality of display windows," but not further-recited details of the "visual representation." Appellants in the briefs did not contest the Examiner's findings with respect to Tang, but contended that the prior art did not teach claimed details of the "visual representation." On the record that was before us, the sole potential novelty with respect to claim 1 was thus the content of the "visual representation." We determined that the "visual representation" is, however,

non-functional descriptive material that is not entitled to patentable weight, in that the relationship between the visual representation and the display is not functional, and the visual representation in no way depends on the method and the method does not depend on the visual representation limitation. Decision 5-6.

Similarly, the Federal Circuit in *King Pharmaceuticals* considered both the method as a whole and the substrate (product) within the method when considering whether a printed label limitation should be entitled to patentable weight. The Court first determined that the subject matter of dependent claim 21, which recited “informing” the patient that the drug administered in accordance with base claim 1 had certain therapeutic effects, was subject to the rationale of “printed matter” cases even though claim 21 was cast as a method. *See King Pharmaceuticals*, 616 F.3d at 1274-79. The Court next addressed claim 22.

Claim 22 is closely related to [“informing”] claim 21. Claim 22 depends from claim 1 and limits claim 1’s method to situations “wherein the metaxalone is from a container with printed labeling advising that administration with food results in an increase in the maximal plasma concentration (Cmax) and extent of absorption (AUC(last)) of metaxalone compared to administration without food.” The district court, relying on this court’s printed matter precedent as articulated in *In re Ngai*, found the claim anticipated by Fathie II, Albanese, and Abrams. *See King Pharms., Inc.*, 593 F.Supp.2d at 513.

Because it depends from claim 1, the printed label limitation is claim 22’s only potential source of novelty. However, as the district court correctly found, the printed label limitation falls squarely within our printed matter cases discussed above with respect to claim 21. While ostensibly a method claim, the potentially novel aspect of claim 22 concerns a printed label on a product. Like claim 21’s “informing”

limitation, the printed label is not functionally related to either the product within the method claim or the method claim as a whole. Therefore, the district court was correct in finding the claim anticipated. *See In re Ngai*, 367 F.3d at 1339.

King Pharmaceuticals, 616 F.3d at 1279-80.

In the present case, the claimed “visual representation” fails to represent a new and unobvious functional relationship with either of the substrate (e.g., electronic display) or the prior art method taught by Tang. The “visual representation” is merely information on a display. The “dynamically displaying” step of claim 1 is not functionally related to the steps of “setting up,” “automatically collecting,” and “automatically determining” that are taught by Tang. Rather, the “dynamically displaying” step provides a visual representation that is useful and intelligible only to the human mind, much like a step of “printing” information on a product to enhance the user’s knowledge.

We are thus not persuaded that our decision was inconsistent with the recent case of *King Pharmaceuticals*. We are therefore not persuaded that our decision to affirm the rejection of claims 1-27 was in error.

DECISION

In summary, we have granted Appellant’s request for rehearing to the extent that we have reconsidered our decision affirming the rejection of claims 1-27, but we decline to modify the decision in any way.

DENIED

Appeal 2009-000934
Application 09/886,876

msc

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